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09/288,757	04/08/1999	FRED L. HOROWITZ	991057	7857

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EXAMINER
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ART UNIT	PAPER NUMBER
2164	

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Please find below and/or attached an Office communication concerning this application or proceeding.

	Application No.	Applicant(s)
Office Action Summary	09/288,757	HOROWITZ ET AL.
	Examiner	Art Unit	
	Sam Rimell	2164	

-- *The MAILING DATE of this communication appears on the cover sheet with the correspondence address* --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE _3_ MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.
- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
  Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☐ Responsive to communication(s) filed on _____.

2a)☒ This action is **FINAL**.   2b)☐ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) _4,6,13,14,16,18 and 28_ is/are pending in the application.

    4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) _4, 6, 13, 14, 16, 18, 28_ is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

    Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

    Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

    a)☐ All b)☐ Some * c)☐ None of:

      1.☐ Certified copies of the priority documents have been received.

      2.☐ Certified copies of the priority documents have been received in Application No. _____.

      3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

    * See the attached detailed Office action for a list of the certified copies not received.

SAM RIMELL
PRIMARY EXAMINER

Attachment(s)

1)☐ Notice of References Cited (PTO-892)

2)☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)

3)☐ Information Disclosure Statement(s) (PTO/SB/08)
    Paper No(s)/Mail Date _____.

4)☐ Interview Summary (PTO-413)
    Paper No(s)/Mail Date. _____.

5)☐ Notice of Informal Patent Application

6)☐ Other: _____.

The following is a quotation of the first paragraph of 35 U.S.C. 112:

> The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

Claim 28 is rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention.

Claim 28: Claim 28 has been amended to recite "without having first only indicated whether the participant has benefits coverage". This feature is a negative limitation which is not supported by the original disclosure. MPEP 2173.05(i) states:

Any negative limitation or exclusionary proviso must have basis in the original disclosure... The mere absence of a positive recitation is not basis for an exclusion. Any claim containing a negative limitation which does not have basis in the original disclosure should be rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement.

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

Claims 4, 6, 13-14, 16, 18 and 28 are rejected under 35 U.S.C. 103(a) as being unpatentable over Pritchard (U.S. Patent 4,491,725) in view of Boyer et al. (U.S. Patent 6,208,973) and further in view of Doyle, Jr. et al. (U.S. Patent 5,070,452).

Claim 4: Pritchard discloses a system (FIG. 1) for determining insurance eligibility and payment for medical procedures. Pritchard discloses a first computer (26) having at lease one data storage means (files and tables as shown at 26), and input/output means (each communication line 22, 24, 32 and 34 is both an input and output means to the first computer 26 since each permits two-way communication).

Data pertaining to the participant is stored in a patient file at (26). The collective set of patient files constitute a database. These files are not stored on a second computer (10).

The second computer is shown at (10). This second computer (10) includes means for inputting a participant identifier simultaneously with an indicator of a particular procedure (the HCFA form which requests the patient information and procedure information together on one form, col. 7, lines 41-42, 45-46 and 49-50).

The first computer also includes means for searching for the participant identifier to identify the participant (programming steps to find the participant and validate their card, col. 7, lines 20-30).

The first computer (26) further includes means for providing the participant data to the second computer in the form of : (1) name of the participant; (2) benefits carrier as the insurance company; (3) a service number readable as an account number; (4) dental benefit coverage in the form of a dollar amount. This information indicates eligibility for coverage and level of coverage in terms of dollars.

The second computer (10) further includes second input means (keyboard or any of the input means 60-66 shown in FIG. 4) which permit input of inquiries. Response to the inquires are made in real time in the sense that the information is provided back to the medical care provider

"rapidly" (col. 3, line 30) and while the patient is still with the provider (col. 6, lines 64-66 and col. 12, lines 14-15). The participant's data to the second computer (10) in not sent advance of the determination (col. 7, lines 25-28 returns only a yes/no validation, the participant's data is not returned to the second computer (10) until FIG. 8, where the participant data is shown with the determination).

The recordation of utilization of benefits can be accomplished by the insurance carriers (36, 38) or the bank (40) which record transaction which take place and are associated with the first computer (10) by communications links over a common network (FIG. 1). The recordation may also be record presented on the output screen in FIG. 8.

Pritchard differs in that it does not disclose the communication links between the computers as accomplished by the World Wide Web (i.e. the Internet). However, such interconnection is taught by Boyer et al. at (14) in FIG. 1. It would have been obvious to one of ordinary skill in the art to modify the system of Pritchard to utilize the World Wide Web (i.e. the Internet) as the communications medium between computers so as to eliminate the need to construct a dedicated private network and by utilizing a readily available network

Pritchard differs in that it does not disclose the second computer as residing in a dental care office where it is usable by a dental care provider. However, Doyle Jr. et al. teaches a computer terminal (18) highly analogous to the computer (10) in Pritchard except that it can be used by a dentist in a dental practice (col. 9, lines 10-15 and line 29). It would have been obvious to one of ordinary skill in the art to utilize the system of Pritchard in a wide array of medical practices, including dental practices, so as to permit a more practitioners access to the system as taught by Doyle Jr. et al.

Claim 6: Pritchard discloses the input of procedure codes (col. 8, lines 12-13). The input of other procedure related data, such as tooth identifications and tooth positional identification would further have been obvious to one of ordinary skill in the art to clarify the exact nature of the procedure being performed.

Claim 13: The "first computer" is (26) and the second computer is (10). Pritchard discloses a method for providing information to physicians regarding participants in an insurance plan. The method involves determination of eligibility for claim payments and involves the steps of:

Inputting identifier data and particular procedure pertaining to a participant on a first computer as a single step inquiry to a database containing participant data regarding a plurality of insurance carriers (col. 7, lines 37-63, the steps of filling out the HCFA form that includes the participant data and procedure information. The form is filled out on the first computer 10 and input to the second computer 26);

Searching for identifier data in the participant data (col. 7, lines 20-23);

Providing output in the form of participant data provided as a response to the inquiry in real time (FIG. 8) without the need to send the participant data in advance (FIG. 8 is the first output of participant data, the previous output described at col. 7, lines 25-28 is only a Yes/No validation) and where the output comprises an indication of correctness or non-correctness for the input procedure (FIG. 8, which illustrates that the procedure is correct since a claim payment is authorized by the insurer for the patient identified as John M. Doe).

The inputting step is performed in real time (col. 3, line 30, col. 6, lines 64-66 and col. 12, lines 14-15) and the inputs are transmitted to the second computer (26). The inputs may be made prior to the procedure itself (col. 6, lines 64-66).

The recordation of the utilization of benefits may be made by the insurer (36, 38), the bank (40) or it may be recorded on the output screen in FIG. 8. The recordation is based upon the input of the participant data and procedure data into the HCFA form.

Pritchard differs in that it does not disclose the communication links between the computers as accomplished by the World Wide Web (i.e. the Internet). However, such interconnection is taught by Boyer et al. at (14) in FIG. 1. It would have been obvious to one of ordinary skill in the art to modify the system of Pritchard to utilize the World Wide Web (i.e. the Internet) as the communications medium between computers so as to eliminate the need to construct a dedicated private network and by utilizing a readily available network

Pritchard differs in that it does not disclose the second computer as residing in a dental care office where it is usable by a dental care provider. However, Doyle Jr. et al. teaches a computer terminal (18) highly analogous to the computer (10) in Pritchard except that it can be used by a dentist in a dental practice (col. 9, lines 10-15 and line 29). It would have been obvious to one of ordinary skill in the art to utilize the system of Pritchard in a wide array of medical practices, including dental practices, so as to permit a more practitioners access to the system as taught by Doyle Jr. et al.

Claim 14: Input data is inherently viewed in real time, since it is seen while it being entered in the computer. The output from the input data is also real time, since it is seen while the patient is with the physician (col. 6, lines 64-66).

Claim 16: The inputs to the HCFA form are the inputs derived from the MediCard (col. 7, lines 45-46), which are described at col. 5, lines 26-32. This includes a date of birth. The remaining features in claim 16 are optionally recited (see the phrase "at least one of").

Claim 18: See remarks for claim 6.

Claim 28: See remarks for claim 4. With respect to the last two paragraphs of claim 28, note that the system of Pritchard in FIG. 8 provides an indication of benefit eligibility (insurance eligibility) and level of coverage (payment amount) simultaneously in one output in FIG. 8. The negative limitation of "without having first only indicated whether the participant has benefits coverage" is met by Pritchard. Prior to the display screen of FIG. 8, the physician or dentist can be transmitted a claim form when the insurance card is validated (col. 7, lines 37-40). Since the physician or dentist in Pritchard can receive displays beyond the "only an indication of benefits coverage" in the negative limitation, the negative limitation is met by Pritchard.

Remarks

Applicant's arguments have been considered. Applicant's arguments are directed to the feature in each of claims 4, 13 and 28 calling for real time interaction. Applicant argues that Pritchard does not permit real time interaction since the response time from the first computer (26) is alleged to be several hours. This argument is incorrect. The Pritchard reference contains no suggestion that the data return time from the first computer (26) to the second computer (10) is several hours. Pritchard does state that the complete processing, including electronic funds transfer (col. 9, lines 55-61), can take several hours, but Pritchard does not suggest that merely providing data to the terminals takes several hours. Accordingly, applicant's argument is mere speculation. Examiner maintains that even when Pritchard is taken alone, it provides for real

time interactions, which are suggested at col. 7, lines 12-24 and col. 6, lines 64-66, where a patient can receive feedback while still with the physican. Additionally, Pritchard has been combined with Boyer to suggest the usage of the Internet as the intermediary network, further supporting any manner of real time interaction, which is a characteristic of the Internet.

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication should be directed to Sam Rimell at telephone number (571) 272-4084.

Sam   Rimell
Primary Examiner
Art Unit 2164